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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,164	07/02/2001	Eric C. Haseltine	530057-319	2603

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THE WALT DISNEY COMPANY
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SANTA MONICA, CA 90404

EXAMINER

CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/898,164

Applicant(s)

HASELTINE ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 38-46 and 51-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 38-46 and 51-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>30 Nov 06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with an amendment on 30 November 2006 have been fully considered but they are moot in view of the following new basis of rejection.

Claim Rejections - 35 USC § 102 and 35 USC § 103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 6, 7, 9-11, 38-42 and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Mankovitz et al. (US005500681A).
5. Mankovitz et al. teaches (independent claims 1, 38 and 46) a method and system to receive information/advertising and for marketing to consumers, the method comprising:

providing a programming broadcast signal (*television transmission signals*) to a broadcast receiving appliance (*controller 12*) and providing a token (*VBI data*) with the programming broadcast signal (col. 3 lines 44-48 and col. 2 lines 24-26);

displaying the television programming to the user (col. 3 lines 44-46) and radiating the token to the *portable electronic coupon* (col. 3 lines 44-49), which reads radiating an audio signal or video display including the token with the programming to a user from the broadcast receiving appliance;

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providing a token capture device (*portable electronic coupon*) to the user configured to receive the token during the radiating of the programming (col. 3 lines 47-54); and

providing an incentive to a user (*discounts on merchandise or services*, col. 5 lines 26-29) for using the token capture device/*portable electronic coupon* to receive the token.

For claim 46, Mankovitz et al. also teaches an audio token (col. 1 lines 16-18 and 46-56 and col. 5 line 62).

6. Mankovitz et al. also teaches at the citations given above claims 2, 4, 6, 9, 11, 41, 42 and 46. Mankovitz et al. also teaches claims 3 (col. 1 lines 18-19), 7 (col. 3 lines 50-54) and 10, 39 and 40 (col. 8 lines 35-41, where a *discount* or any other benefit reads on a "prize").
7. Claims 5, 8 and 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz et al. (US005500681A).
8. Mankovitz et al. does not teach a light token (claim 5), which is interpreted as visible light. A light token would be obvious because light signals were an early form of TV remote control. Mankovitz et al. does not teach radio broadcast (claims 8 and 44). Radio broadcast would be obvious because Mankovitz et al. does teach an audio token (para. 5 above). Mankovitz et al. does not teach (claims 43 and 45) that the broadcast signal comprises motion picture film or computer software. The former is obvious as the full motion video commonly broadcast in retail venues, and the latter is obvious as executable programming broadcast in the same venues.
9. Claims 12, 13 and 51-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz et al. (US005500681A) in view of Clarke (US005502636A).
10. Mankovitz et al. does not teach (independent claim 51) providing a registration venue, gathering consumer information at said venue, entering the information in a database, and preparing promotional material based on the token information and consumer information in the database. Clarke teaches providing a registration venue, gathering consumer information at said venue and entering the information in a database (*profile database 24*, col. 2 lines 48-51). Clarke also teaches using the coupon redemption data consumer data to improve product marketing (col. 3 lines 1-8), which reads on preparing promotional material based on the token information and consumer information in the database. Because Clarke teaches that it is desirable to target and track certain audiences (col. 1 lines

21-28), and because this personal targeting improves reduces fraud (col. 3 lines 11-13), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Clarke to those of Mankovitz et al.

11. Clarke also teaches claims 12, 13 and 52-57 at the citations given above.
12. Neither reference teaches preparing promotional information based, at least in part, on the information in the database which reads on preparing promotional based, at least in part, on the information in the database.

Conclusion

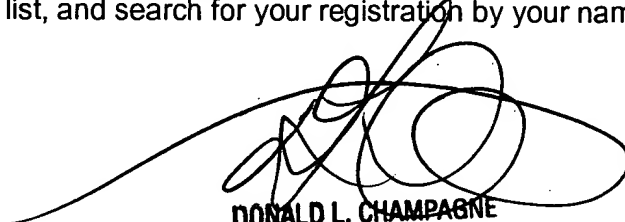
13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
14. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.
16. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724.
17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information

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for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

18. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
19. Applicant may have after final arguments considered and amendments entered by filing an RCE.
20. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

10 February 2007



DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
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